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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,616	12/30/2003	Kothapalli Venkata Surya Narayana Raju	C261 1040.1	2874

26158 7590 01/24/2007
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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/747,616

Applicant(s)

RAJU ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 3, 5-20 have been cancelled by Applicant

Specification

2. The amendment filed 10/27/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the omission of the NILSET™ 117, HAPCO™ NXZ, and BORCHI® GOI E2 from the recited coating composition. The disclosure as originally filed appears to require the presence of the above three components and therefore does not provide support for coating compositions which do not contain the said three newly omitted components.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention in objection under U.S.C. 132(a) to the amendment filed 10/27/2006. The disclosure as originally filed appears to require the presence of the above three components in the coating compositions and therefore does not provide support for coating compositions which do NOT contain the said three newly omitted components.

5. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

6. Claims 1-2, 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-2, 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites numerous trademarks and/or tradenames (e.g., Nilset117, HapcoNXZ, etc.) which are not adequately described or specified in the specification as originally filed. The specification fails to provide any information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

9. Claims 1-2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

KUO ET AL (US 2003/0195292) or KUO ET AL (US 2002/0183453),
in view of KYMINAS ET AL (US 4,749,731).

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KUO ET AL '292 and '453 disclose coating compositions containing alkyd-based resin binders and typically 30-60 wt% of at least one pigment (e.g., titanium dioxide, barites, clay, etc.), wherein the coating composition further contains various known coating additives (e.g., anti-settling agents, dispersing agents, extenders, etc.). (KUO ET AL '292, paragraphs 0033-0040) (KUO ET AL '453, paragraphs 0026-0038) However, the reference does not explicitly disclose the recited amounts of various pigments.

KYMINAS ET AL discloses that it is well known in the art to incorporate a combination of pigments into a coating composition, wherein the compositions typically contain 3-25 wt% titanium dioxide, 5-30 wt% talc, and 1-25 wt% calcined clay in order to obtain a highly durable protective pigmented coating for exposed surfaces. (line 50-62, col. 4; line 45-66, col. 5; line 25-38, col. 6)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize combinations of known pigments in the coating compositions of KUO ET AL '292 or '453 in order to tailor the visual appearance, hiding power, durability, and other physical properties of the resultant coatings for specific applications. It also would have been obvious to use effective amounts of known performance-enhancing additives in the coating compositions in order to improve the coating characteristics of the composition and the physical properties of the resultant coating.

Response to Arguments

10. Applicant's arguments filed 10/27/2006 have been fully considered but they are not persuasive.

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(A) Regarding the rejections under 35 USC 112, first paragraph, and 35 USC 112, second paragraph, based on the usage of trademarks and/or tradenames, said rejections remain outstanding because the specification as originally filed fails to provide *any* information or generic terminology (e.g., chemical composition, function, etc.) which would adequately identify the recited compounds to one of ordinary skill in the art.

(B) Applicant fails to specifically address the second grounds of rejection based on 35 USC 103(a) as set forth in paragraph 10 in the previous Office Action (the KUO ET AL references in view of KYMINAS ET AL) which is different from the first grounds of rejection as set forth in paragraph 9 of the previous Office Action.

(C) The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the KUO ET AL references generally disclose the alkyd coating compositions containing the recited pigments, while KYMINAS ET AL discloses that it is well known in the art to combinations of titanium oxide and clay in coating compositions in order to obtain specific functional and/or aesthetic effects. Applicant has not provided any probative evidence of criticality and/or unexpected results from the recited combination of pigments.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 19, 2006



Vivian Chen
Primary Examiner
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